

JAN 18 2007

REMARKS

In response to the Office Action mailed October 18, 2006, the applicants respectfully request reconsideration. In the Office Action, claims 1-5, 7-10, 12-17 and 19-23 were rejected and claims 6, 11 and 18 were objected to. By this amendment, claim 23 has been canceled and claim 24 has been added. Accordingly, claims 1-22 and 24 are pending in the application.

Claim Rejections Under 35 U.S.C. §103

Claims 1-5, 7-10, 12-17 and 19-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Maxim Data Sheet 19-2735, Rev 0, 1/03 in view of Suessmilch. This rejection is respectfully traversed, as there is no motivation to combine the cited references, as is required for a proper rejection under 35 U.S.C. §103.

The Maxim Data Sheet teaches an ORing MOSFET controller that provides fault isolation for redundant power supplies by providing a reverse current detection feature. Suessmilch teaches an overcurrent protective circuit. There is no teaching or suggestion in the Maxim Data Sheet of the desirability to include an overcurrent protection device therein, nor is there any teaching or suggestion in Suessmilch of the desirability to include a reverse current detection feature therein. The examiner states that it would be obvious to combine the teachings of Maxim with Suessmilch for the purpose of providing the Maxim device with overcurrent protection. However, the examiner provides no evidence in the prior art that suggests the desirability of the claimed invention. See MPEP §2143.01:

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references.

Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

Patent EMC-04-008
U.S.S.N.: 10/812,429

As set forth by the Federal Circuit, “In establishing a *prima facie* case of obviousness under 35 USC 103, it is incumbent upon the Examiner to provide a ‘clear and particular’ showing of ‘actual evidence’ of a suggestion, teaching, or motivation to combine references.” In re Dembiczak, 50 USPQ 2d, 1614, 1617 (Fed. Cir. 1999). “Broad conclusory statements regarding the teachings of multiple references, standing alone, are not evidence.” Id., citing McElmury v. Arkansas Power and Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993). (internal quotations omitted).

In fact, in In re Dembiczak, the Court of Appeals for the Federal Circuit recognized that “rigorous application” of the requirement for a showing of a teaching or motivation to combine references is the “best defense against the subtle but powerful attraction” of improper hindsight-based obvious analysis. Id.; See also, Para-Ordnance Manufacturing, Inc. v. SGS Importers International, Inc., 73 F.3d 1085, 37 USPQ2d 1237 (Fed. Cir. 1995). (“obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor”). This is especially true in cases where the ease with which the invention may be understood “may prompt one to fall victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher.” Id. citing W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

Clearly, since there is no teaching or suggestion of the desirability of the claimed invention in either of the references, and the examiner has not provided any such evidence, the only source of the desirability is the applicants’ specification. Consequently, the combination is a result of improper hindsight reasoning, which, as set forth above, is not permissible under 35 U.S.C. §103.

Regarding the examiner’s assertion that the combination would be obvious, applicants disagree for the reasons set forth above. Applicants further note that the examiner has provided absolutely no evidence of such obviousness, or of the desirability to combine the references. Applicants refer the examiner to MPEP §2144.03A:

As the court held in Zurko, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. Id. at 1385, 59 USPQ2d at 1697.

Patent EMC-04-008
U.S.S.N.: 10/812,429

Accordingly, because the examiner has not based the rationale for the combination on any evidence in the record, applicant requests that the examiner produce authority for his assertion that the combination is obvious. As set forth in MPEP §2144.03C, the examiner must provide documentary evidence in the next Office Action if the rejection is to be maintained.

Therefore, because the combination relied upon by the examiner is improper, claims 1-5, 7-10, 12-17 and 19-22 are allowable and the rejection of claims 1-5, 7-10, 12-17 and 19-22 under 35 U.S.C. §103 should be withdrawn.

Claim 23 has been canceled.

Claim 24 has been added to further define applicants' contribution to the art.

Allowable Subject Matter

Applicants acknowledge and appreciate the examiners indication that claims 6, 11 and 18 would be allowable if rewritten in independent form. However, since the claims from which these claims depend are allowable, applicant asserts that amending these claims is not necessary.

Based on the foregoing, applicants respectfully assert that claims 1-22 and 24 are allowable over the art of record and respectfully request that a timely Notice of Allowance be issued in this application.

In the event the Parent Office deems personal contact desirable in disposition of this matter, the Office is invited to contact the undersigned attorney at (508) 293-7835.

Patent EMC-04-008

U.S.S.N.: 10/812,429

Please charge any fees occasioned by this submission to Deposit Account
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Respectfully submitted,

Dated: _____

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